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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,457	03/28/2001	Michael J. Borg	10006799-1	6674

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EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,457

Applicant(s)

BORG ET AL.

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/28/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Dependent claims 5, 6, 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are written in passive state which are vague and indefinite for a method claim. Conversion to positive/active state are recommended to improve clarity.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20-23 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over HARDMAN et al (US 2002/007 5145).

As for Independent Database claim 20, which deals with a database comprising a plurality of records, HARDMAN et al discloses a database comprising a plurality of record, each record further comprising:

(a) a customer field that contains a value that uniquely identifies a customer {see Fig. 29, [0107-0122]};

(b) a product field that contains a product identifier that identifies a product used by the customer {see Figs. 31, 25, [0142-0149]};

(c) a product information field that contains information related to the product identified in the product field {see Figs. 32, [0142-0149]};

(d) a customer information field that contains information related tot the customer identified in the customer field {see Fig. 29, 0145-0151]};

(e) a product usage field that contains information related to how the product identified in the product field is used by the customer identified in the customer field {see Figs. 25-29, [0107, 0108, 0110, 0112, 0150-0151]}.

Alternatively, on [0309, 0145-0149], HARDMAN et al teaches the collection, monitoring and management of other relevant embodiments if desired (besides the related tire tag), therefore, it would have been obvious to collect other relevant information if desired such as about the customer information.

As for dep. claim 21 (part of 20), which deals with instruction to follow when certain information meets certain criteria, this is taught in [0024-0235]. Alternatively, the application of other well known business instruction, i.e. free replacement of product or

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material for malfunction within the 1st year of normally guaranteed performance, would have been obvious to a skilled artisan.

As for dep. claim 22 (part of 20), which deals with further limitation of a field comprising information related to a history of communications with the customer, this is shown in [0119, 0024, 0309], Figs. 25, 29. Alternatively, the collection of other desired information would have been obvious in view of the teachings of [0309, 0313, 0119], absent evidence of unexpected results.

As for dep. claim 23 (part of 20), which deals with further limitation of a field comprising information about other products purchased by the customer, this is shown in [0309], Figs. 29-31. Alternatively, the collection of other desired information would have been obvious in view of the teachings of [0309, 0313, 0119].

5. Claims 1-9 (method¹), 16-19 (method²), 10-15 (apparatus¹) are rejected under 35 U.S.C. 103(a) as being unpatentable over HARDMAN et al in view of Applicant Admitted Prior Art (AAPA).

As for Independent **Method¹ Claim 1**, HARDMAN et al discloses an electronic component management system/method comprising:

- (a) retrieving device (vehicle) data from component memory of a replaceable component (tire) of a device used by a customer {see Figs. 12, 25, [0107]}
- (b) storing the data in a customer database {see Figs. 12, 25, [0108, 0111]}
- (c) associating the data with the customer; {see Figs. 29, "User ID", "First name", "Telephone number", and [0145-0150]} and

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(d) accessing the data in the customer database to assist the customer with solving problems related to the device {see Figs. 20, 23, 24, 25, 26, 31 "Editing Vehicle", [0003: "must be regularly maintained to maximize device efficiency", [0120: "transmit alarm signals when a parameter is out of range]; [0205: "function satisfactory within the specified load carrying capacity", and especially [0234: "need of service, ..., can be attended to immediately, "service can be directed to only problem tires and efficiency in service can be achieved. ... identification of problems early.. for evaluation.... to alarm personnel to the need for service to a particular tire], [0235: Fig. 20... an unacceptable condition illustrating that a problem has occurred with that tire]}. HARDMAN et al fairly discloses the claimed invention except for the type of device, i.e. printing device.

AAPA, as shown in the Background, discloses a printing device with well known issue of replacing replaceable component, i.e. toner cartridge, and problems of lacking information or database monitoring printing device information for the customer service operator to review automatically when problems arise and relying on the skills of the customer service operator. The information about the customer is limited on a registration card which would require manually searching and finding the item. **It would have been obvious** to modify the teaching of HARDMAN et al by applying to other well known device with replaceable component such as printing device as taught by AAPA as mere applying similar steps to other similar device to achieve similar results, absent evidence of unexpected results. Moreover, it would have been obvious to replace the manual customer reviewing process, on a registration card, with the automation

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computer customer database process as taught by HARDMAN et al. Furthermore, this would inherently resolve the problems of lacking ways to electronically manage/monitor the printing device as mentioned in the Background of the Invention.

As for dep. claims 2-3 (part of 1), which deals with the type of printing device data, i.e. information about the printer or usage of the printer, these are non-essential to the claimed invention and are fairly taught in HARDMAN et al Fig. 31, [0119, 0145, 0149, especially 0265, 0309 (mileage usage)]}.

As for dep. claims 4-5 (part of 1), which deals with the type of data accessing, i.e. previous stored database information related to the customer, these are non-essential to the claimed invention and are fairly taught in HARDMAN et al {[0150 - 0151], [0169: updating tire history data]}.

As for dep. claim 6 (part of 1), which deals with the type of data accessing, i.e. previous stored database information derived from information on a registration card, this is non-essential to the claimed invention and are fairly taught in HARDMAN et al {[0145, 0152]}.

As for dep. claim 7 (part of 1), which deals with the type of printer and replaceable component, this is non-essential to the claimed invention, and would have been obvious to a skilled artisan since the selection of any well known conventional would have been obvious, absent evidence of unexpected results.

As for dep. claim 8 (part of 1), which deals with associating certain rules (or specification or standard) to be followed, this is non-essential to the claimed invention and is fairly taught in [0224]. Moreover, this would have been obvious to a skilled

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artisan as mere applying other well known business parameters or variables since the selection of any well known business rules for compensation of irregular product or service would have been obvious, i.e. free replacement of product or service for malfunction within the 1st year of normally guaranteed performance.

As for dep. claim 9 (part of 1), which deals with other step for testing the component for defect and storing the information, this is non-essential to the claimed invention and is fairly taught by HARDMAN et al in [0234-0235].

As for Independent Method² claim 16, which is similar to claim 1 with a preamble as shown in step (d) of 1, It's rejected for the same reason set forth in claim 1 above.

As for dep. claim 17 (part of 16), which is similar to claim 1 with a limitation as shown in step (b) of 1, It's rejected for the same reason set forth in claim 1 above.

As for dep. claim 18 (part of 16), which is similar to dep. claim 6 (of 1), it's rejected for the same reason set forth in dep. claim 6 above.

As for dep. claim 19 (part of 16), which is similar to claim 1 with a limitation as shown in step (c) of 1, It's rejected for the same reason set forth in claim 1 above.

As for Independent Apparatus¹ claim 10, HARDMAN et al discloses a system comprising:

(a) a center to receive a used device replaceable component (tire) from a device of a customer, the component including memory tag integrated therewith; {see 0107, 0119, Fig. 12}}

(b) a customer database that stores customer information for multiple customers, including device and component used by the customers; {see Fig. 12, [0109, 0110, 0139]}

(c) a data transfer center wherein the data is retrieved from the component memory and stored in the customer database; and {see 0119, Fig. 12}

(d) customer center configured to provide access to the customer database so that the operator can view the device data {see 0150, Figs. 23-30}.

As for the limitation of a recycling center, this is fairly taught in [0119] wherein a tire shop or dispatch can function as recycling center. Moreover, this limitation is merely recites the function of the center which carries no patentable weight and no elemental structures with respect to the “recycling” function have been shown. HARDMAN et al fairly teaches the method of claim 10 except for the type of the device, i.e. printing device (or printer) and (d) customer service center configured to receive calls from the customer.

AAPA, as cited in the background of the invention, AAPA, as shown in the Background, discloses a printing device with well known issue of replacing replaceable component, i.e. toner cartridge, and problems of lacking information or database monitoring printing device information for the customer service operator to review automatically when problems arise and relying on the skills of the customer service operator. The information about the customer is limited on a registration card which would require manually searching and finding the item. **It would have been obvious** to modify the teaching of HARDMAN et al by applying to other well known device with

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replaceable component such as printing device as taught by AAPA as mere applying similar steps to other similar device to achieve similar results, absent evidence of unexpected results. Moreover, it would have been obvious to replace the manual customer reviewing process, on a registration card, with the automation computer customer database process as taught by HARDMAN et al. Furthermore, this would inherently resolve the problems of lacking ways to electronically manage/monitor the printing device as mentioned in the Background of the Invention. Furthermore, this would inherently resolve the problems of lacking ways to electronically manage/monitor the printing device as mentioned in the Background of the Invention.

As for dep. claims 11, 12 (part of 10), which have similar limitations as in dep. claims 3, 2 respectively above, they are rejected for the same reasons set forth in claims 3 and 2 above.

As for dep. claims 13, 14 (part of 10), which have similar limitations as in dep. claim 9 above, they are rejected for the same reasons set forth in claim 9 above.

As for dep. claim 15 (part of 10), which have similar limitations as in dep. claim 7 above, they are rejected for the same reasons set forth in claim 7 above.

6. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over HARDMAN et al as applied to claims 20-23 above, and further in view of AAPA.

As for dep. claims 24-25 (part of 20), which have similar limitations as in claim 1 above, they are rejected for the same reason set forth in claim 1 above.

In Summary

Note on [0309] and [0313], HARDMAN et al discloses that any other desired device or parameters can be implemented and that other elements, steps, methods and techniques that are insubstantially different from those described herein are also within the scope of the invention. Thus, the scope of the invention should not be limited by the particular embodiments described herein but should be defined by the appended claims and equivalents thereof. Changing to other type of device or component would be considered as selecting other equivalent device and component and would have been obvious, absent evidence of unexpected results.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,029,031 discloses well known fact of cartridge recycling plant for collecting cartridge and reuse.

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8. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113 or see <http://pair-direct@uspto.gov>.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
December 7, 2004


DEAN T. NGUYEN
PRIMARY EXAMINER